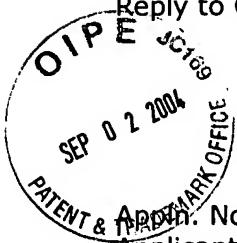


Appln: No. 10/712,086
Petition Dated August 31, 2004
Reply to Office Action of June 4, 2004

YAO-3750US2



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No: 10/712,086
Applicants: Kazuhisa Yamamoto et al.
Filed: November 13, 2003
Title: OPTICAL DEVICE, LASER BEAM SOURCE, LASER APPARATUS
AND METHOD OF PRODUCING OPTICAL DEVICE
T.C./A.U.: 2828
Examiner: Minsuh Oh Harvey
Confirmation No.: 7925
Docket No.: YAO-3750US2

PETITION

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Petition seeks the issuance of a Notice to Vacate the Office Action issued June 4, 2004, which was issued in error by the United States Patent & Trademark Office.

The Patent Office, by the OIPE, issued to Applicants a Notice of Non-Compliant Amendment (37 C.F.R. 1.121) dated June 4, 2004, a copy of which is enclosed. According to the Notice, the amendment document filed on June 13, 2003 is considered non-compliant because it has failed to meet the requirements of 37 C.F.R. 1.121. The basis for the Notice was stated as the "Article 34 Amendment is unsigned" (emphasis added). It is Applicants' contention that the filing of the English Translation of an Article 34 with the filing of the above identified application was proper, and that there was no requirement or need to file a signed copy of the Article 34 Amendment.

The above identified application is a divisional of U.S. Patent Application No. 09/922,978, filed August 6, 2001, which is a divisional of U.S. Patent Application No. 08/073,380, now U.S. Patent No. 6,333,943. The parent application was an international application and thus, in filing the above identified application, Applicants included a copy of the English Translation of the Article 34 Amendment filed with the parent application.

Upon receiving the Notice of Non-Compliant Amendment, on June 7, 2004, the undersigned spoke with Eva Gillis, the Legal Instruments Examiner, who signed the Notice, and her supervisor, Ms. Tubbs. According to a follow-up telephone conference on June 8, 2004, Ms. Tubbs stated that the US PTO made an error in issuing the Notice of Non-Compliant Amendment, and that a Notice to Vacate the Office Action would be issued.

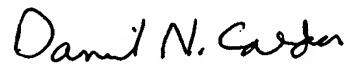
As the due date for response to the Notice of Non-Compliant Amendment approached, Applicants had not received the Notice to Vacate the Office Action, and therefore filed a Status Request and Response to Office Action, on June 30, 2004, a copy of which is enclosed.

After filing the Status Request and Response to Office Action, the undersigned followed up with a telephone call to Examiner Don Kitsun Wong of Art Group 2821, who advised the undersigned that the application had been reassigned to Examiner Harvey. The undersigned then contacted Examiner Harvey who advised him that the matter had to be taken care of within the OIPE. The undersigned then made numerous attempts to contact Ms. Tubbs, the supervisor to Eva Gillis, the Legal Instruments Examiner, who initially issued the Notice of Non-Compliant Amendment. After several weeks of failed attempts in reaching Ms. Tubbs, the undersigned has found it necessary to file this Petition.

Applicants therefore request that in view of the error by the US PTO, a Notice to Vacate the Office Action issued June 4, 2004 be issued.

With the filing of this Petition, Applicants are paying the \$130.00 Petition fee, but because the Petition was necessitated because of PTO error, Applicants request a refund of \$130.00 to Deposit Account No. 18-0350.

Respectfully submitted,



Daniel N. Calder, Reg. No. 27,424
Attorney for Applicants

DNC/lcf

Enclosures: Copy of Notice of Non-Compliant Amendment;
Copy of Status Request and Response;
Copy of Return Receipt Postcard;
Petition Fee

Dated: August 31, 2004

P.O. Box 980
Valley Forge, PA 19482-0980
(610) 407-0700

Appln: No. 10/712,086
Petition Dated August 31, 2004
Reply to Office Action of June 4, 2004

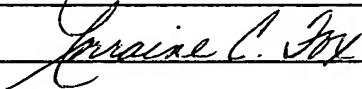
YAO-3750US2

The Commissioner for Patents is hereby authorized to charge payment to Deposit Account No. 18-0350 of any fees associated with this communication.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

August 31, 2004

Lorraine C. Fox



LCF_I:\YAO\3750US2\PETITION.083104.DOC



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

| | |
|----------------------|---------------------|
| Application Number | 10/712,086 |
| Filing Date | November 13, 2003 |
| First Named Inventor | Kazuhisaya Yamamoto |
| Art Unit | 2828 |
| Examiner Name | Minsuh Oh Harvey |
| Attorney Docket No. | YAO-3750US2 |

ENCLOSURES (Check all that apply)

| | | |
|--|---|--|
| <input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/Declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation, Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ | <input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Copy of Notice of Non-Compliant Amendment; Copy of Status Request and Response; Copy of Return Receipt Postcard; Postcard |
| <u>Remarks:</u> | | |

SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

| | | | |
|-------------------------------|------------------|-----------------------------------|--------|
| Firm or Individual Name | Daniel N. Calder | Registration No. (Attorney/Agent) | 27,424 |
| Signature | | | |
| Date | August 31, 2004 | | |

CERTIFICATE OF TRANSMISSION / MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this date:

| | | | |
|--------------------------|-----------------|------|-----------------|
| Typed or printed name | Lorraine C. Fox | | |
| Signature | | Date | August 31, 2004 |

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, ALEXANDRIA, VA 22313-1450.

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FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT

(\$ 130)

| Complete if Known | |
|----------------------|-------------------|
| Application Number | 10/712,086 |
| Filing Date | November 13, 2003 |
| First Named Inventor | Kazuhisa Yamamoto |
| Examiner Name | Minsuh Oh Harvey |
| Art Unit | 2828 |
| Attorney Docket No. | YAO-3750US2 |

METHOD OF PAYMENT (check all that apply)

 Check Credit Card Money Other None Order
 Deposit Account (use as backup only):

Deposit Account Number

18-0350

Deposit Account Name

RatnerPrestia

The Director is authorized to: (check all that apply)

-
- Charge fee(s) indicated below
-
- Credit any overpayments
-
- Charge any additional fee(s) or any underpayment of fee(s)
-
- Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Small Entity

| Fee Code | Fee (\$) | Fee Code | Fee (\$) | Fee Description | Fee Paid |
|----------|----------|----------|----------|------------------------|----------|
| 1001 | 770 | 2001 | 385 | Utility filing fee | |
| 1002 | 340 | 2002 | 170 | Design filing fee | |
| 1003 | 530 | 2003 | 265 | Plant filing fee | |
| 1004 | 770 | 2004 | 385 | Reissue filing fee | |
| 1005 | 160 | 2005 | 80 | Provisional filing fee | |

SUBTOTAL (1)

(\$ 0)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

| Total Claims | -20** | = | 0 | X | Fee from below | = | 0 | Fee Paid |
|--------------------|-------|---|---|---|----------------|---|---|----------|
| Independent Claims | -3** | = | 0 | X | | = | 0 | |
| Multiple Dependent | | | | X | | = | 0 | |

Large Entity Small Entity

| Fee Code | Fee (\$) | Fee Code | Fee (\$) | Fee Description |
|----------|----------|----------|----------|--|
| 1202 | 18 | 2202 | 9 | Claims in excess of 20 |
| 1201 | 86 | 2201 | 43 | Independent claims in excess of 3 |
| 1203 | 290 | 2203 | 145 | Multiple dependent claim, if not paid |
| 1204 | 86 | 2204 | 43 | ** Reissue independent claims over original patent |
| 1205 | 18 | 2205 | 9 | ** Reissue claims in excess of 20 and over original patent |

SUBTOTAL (2)

(\$ 0)

**or number previously paid, if greater; For Reissues, see above

3. ADDITIONAL FEES

Large Entity Small Entity

| Fee Code | Fee (\$) | Fee Code | Fee (\$) | Fee Description | Fee Paid |
|----------|----------|----------|----------|--|----------|
| 1051 | 130 | 2051 | 65 | Surcharge - late filing fee or oath | |
| 1052 | 50 | 2052 | 25 | Surcharge - late provisional filing fee or cover sheet | |
| 1053 | 130 | 1053 | 130 | Non-English specification | |
| 1812 | 2,520 | 1812 | 2,520 | For filing a request for ex parte reexamination | |
| 1804 | 920* | 1804 | 920* | Requesting publication of SIR prior to Examiner action | |
| 1805 | 1,840* | 1805 | 1,840* | Requesting publication of SIR after Examiner action | |
| 1251 | 110 | 2251 | 55 | Extension for reply within first month | |
| 1252 | 420 | 2252 | 210 | Extension for reply within second month | |
| 1253 | 950 | 2253 | 475 | Extension for reply within third month | |
| 1254 | 1,480 | 2254 | 740 | Extension for reply within fourth month | |
| 1255 | 2,010 | 2255 | 1,005 | Extension for reply within fifth month | |
| 1401 | 330 | 2401 | 165 | Notice of Appeal | |
| 1402 | 330 | 2402 | 165 | Filing a brief in support of an appeal | |
| 1403 | 290 | 2403 | 145 | Request for oral hearing | |
| 1451 | 1,510 | 1451 | 1,510 | Petition to institute a public use proceeding | |
| 1452 | 110 | 2452 | 55 | Petition to revive – unavoidable | |
| 1453 | 1,330 | 2453 | 665 | Petition to revive – unintentional | |
| 1501 | 1,330 | 2501 | 665 | Utility issue fee (or reissue) | |
| 1502 | 480 | 2502 | 240 | Design issue fee | |
| 1503 | 640 | 2503 | 320 | Plant issue fee | |
| 1460 | 130 | 1460 | 130 | Petitions to the Commissioner | 130 |
| 1807 | 50 | 1807 | 50 | Processing fee under 37 CFR 1.17(q) | |
| 1806 | 180 | 1806 | 180 | Submission of Information Disclosure Stmt | |
| 8021 | 40 | 8021 | 40 | Recording each patent assignment per property (times number of properties) | |
| 1809 | 770 | 2809 | 385 | Filing a submission after final rejection (37 CFR § 1.129(a)) | |
| 1810 | 770 | 2810 | 385 | For each additional invention to be examined (37 CFR § 1.129(b)) | |
| 1801 | 770 | 2801 | 385 | Request for Continued Examination (RCE) | |
| 1802 | 900 | 1802 | 900 | Request for expedited examination of a design application | |

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3)

(\$ 130)

SUBMITTED BY

Complete (if applicable)

| | | | | | |
|-------------------|-------------------------|----------------------------------|--------|-----------------|--------------|
| Name (Print/Type) | Daniel N. Calder | Registration No. Attorney/Agent) | 27,424 | Telephone | 610/407-0700 |
| Signature | <i>Daniel N. Calder</i> | | Date | August 31, 2004 | |

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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UNITED STATES PATENT AND TRADEMARK OFFICE

SEP 02 2004

PATENT & TRADEMARK OFFICE
U.S. DEPARTMENT OF COMMERCEUNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/712,086 | 06/04/2003 | Kazuhisa Yamamoto | YAO-3750US2 | 7925 |

23122 7590 06/04/2004

RATNERPRESTIA
P O BOX 980
VALLEY FORGE, PA 19482-0980

RECEIVED

JUN 07 2004

RatnerPrestia

EXAMINER

WONG, DON KITSUN

ART UNIT

PAPER NUMBER

2821

DATE MAILED: 06/04/2004

RSP to non-compliant
amendment (1mo)

7/14/04

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No.

Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment document filed on 11-13-03 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see *68 Fed. Reg. 38611*, Jun. 30, 2003). In order for the amendment document to be compliant, correction of the following item(s) is required. Only the corrected section of the non-compliant amendment document must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-submitted. 37 CFR 1.121(h).

THE FOLLOWING CHECKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

1. Amendments to the specification:
 A. Amended paragraph(s) do not include markings.
 B. New paragraph(s) should not be underlined.
 C. Other _____
2. Abstract:
 A. Not presented on a separate sheet. 37 CFR 1.72.
 B. Other _____
3. Amendments to the drawings: _____
4. Amendments to the claims:
 A. A complete listing of all of the claims is not present.
 B. The listing of claims does not include the text of all claims (including withdrawn claims)
 C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified.
 D. The claims of this amendment paper have not been presented in ascending numerical order.
 E. Other: Article 34 Amendment is unsigned

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/ola/preonotice/officeflyer.pdf>.

If the non-compliant amendment is a PRELIMINARY AMENDMENT, applicant is given ONE MONTH from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 U.S.C. 132, and this ONE MONTH time limit is not extendable.

If the non-compliant amendment is a reply to a NON-FINAL OFFICE ACTION (including a submission for an RCE), and since the amendment appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a TIME PERIOD of ONE MONTH from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).

If the amendment is a reply to a FINAL REJECTION, this form may be an attachment to an Advisory Action. The period for response to a final rejection continues to run from the date set in the final rejection, and is not affected by the non-compliant status of the amendment.

Eva Usdilis
Legal Instruments Examiner (LIE)

(571) 272-1577
Telephone No.